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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/901,737

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Edouard G. Lebel

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EXAMINER

KUBELIK, ANNE R

ART UNIT

PAPER NUMBER

1638

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DELIVERY MODE

01/04/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/901,737

Applicant(s)

LEBEL ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 11 December 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 5 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: 47.  
Claim(s) rejected: 35-46 and 48.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☒ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

Continuation of 3. NOTE: New issues: 112, 2nd: It is not clear if the seeds of claims 41 and 48 are transgenic because they comprise the nucleic acid or if they are transgenic because they are transformed with some other nucleic acid..

Continuation of 11. does NOT place the application in condition for allowance because:

112, 1<sup>st</sup>, written description:

Applicant urges that it is not necessary to describe what is known in the art. This is not persuasive because The specification only describes or references T fusca sequences.

Applicant urges that Jung teaches T fusca endoglucanases. This is not persuasive because T fusca endoglucanases are considered described.

Applicant also refers to Giles and Henrissat, but these exhibits will not be considered for the purpose of these arguments because Applicant did not provide a showing of good and sufficient reasons of why they were necessary and not earlier presented, and because they failed to overcome all rejections.

112, 1<sup>st</sup>, enablement:

Applicant urges that the structure, function and sequence of numerous microbial endoglucanases was known and referenced in the specification, and in Gilkes and Henrissat. This is not persuasive; the specification only references a few microbial endoglucanases.

Gilkes and Henrissat will not be considered for the purpose of these arguments because Applicant did not provide a showing of good and sufficient reasons of why they were necessary and not earlier presented, and because they failed to overcome all rejections.

Applicant urges that thermostable endoglucanases from T fusca was compared to other cellulases in Jung in Fig 7 and 8 and pg 3039-3041. This is not persuasive because Jung does not teach the sequences responsible for thermostability and thus does not teach how to make the full scope of thermostable microbial endoglucanases.

103 over Van Ooyen in view of Lao:

Applicant urges that modification of Van Ooyen in the manner suggested would render Van Ooyen's invention unsatisfactory for the intended purpose. This is not persuasive because Van Ooyen et al suggest expressing microbial  $\alpha$ -1,4-endoglucanases in plants (column 4, lines 11-36). Thus, Van Ooyen envisioned the use of microbial endoglucanases as satisfactory for their intended purpose.

Applicant urges that endo-1,4-B-glucanases is mentioned as only one of a laundry list that can be used in conjunction with their invention to alter plant polysaccharides; there is no teaching of using endoglucanase alone or for cellulose degradation. This is not persuasive. The instant claims do not exclude the expressing of other genes; the plants COMPRISE the nucleic acid. The claims are drawn to plants; intended uses of plants are irrelevant for the purposes of prior art.

Applicant urges that Van Ooyen used a tuber specific patatin promoter, not a chemically or wound inducible patatin promoter. This portion of the rejection is withdrawn.

